

REMARKS

Reconsideration of the Application respectfully is requested. For the reasons indicated in detail hereafter the Application is urged to be in condition for allowance.

Filed concurrently herewith is a Petition for Extension of Time (three months) with the appropriate fee.

As requested by the Examiner, additional information concerning the characteristics that are inherently exhibited by the new 'Chanoud' variety has been diligently sought and is provided to the extent available. Such information is provided in the Substitute Specification filed herewith. It respectfully is pointed out that those skilled in plant technology will have no difficulty in identifying plants of the 'Chanoud' variety in view of Applicant's detailed Specification and photograph. The withdrawal of the rejection under 35 U.S.C. § 112 is urged to be in order and is respectfully requested.

It respectfully is pointed out that the request for information under 37 C.F.R. § 1.105 with respect to the public use and availability of the 'Chanoud' plant outside of the United States bears no relationship to the statutory bases for the denial of patent protection pursuant to Title 35 of the United States Code, and accordingly is not justified under the language of 37 C.F.R. § 1.105 since such information is not "reasonably necessary to properly examine or treat the matter." Also, any publication by Applicant that occurred less than one year prior to the January 16, 2001 filing date of the present Application is not relevant under any circumstances.

Additionally, this request with respect to availability of the plant outside the United States constitutes an unannounced substantive departure from prior practices of the United

States Patent and Trademark Office as they have existed for over seventy years that if maintained could substantially limit patent rights and thereby have a substantial adverse impact upon the entire plant industry. Public use and availability of an invention outside the United States is not statutory prior art and is incapable of defeating novelty as defined in the statutory language of Title 35 of the United States Code. Applicant is entitled to continue to rely upon the long-standing practice of the United States Patent and Trademark Office. Accordingly, the recent action by personnel of the United States Patent and Trademark Office is urged to be inappropriate and should be discontinued without delay.

Nevertheless, in a sincere effort to expedite prosecution Applicant provides on information and belief information that was requested to the extent available. It respectfully is submitted that this information when properly evaluated in accordance with the statutory parameters of 35 U.S.C. § 102 presents no statutory impediment to patentability. It is incumbent for all Examiners of the U.S. Patent and Trademark Office to correctly apply the statutory prerequisites for the denial of patent protection. Examiners have no discretion to apply a different standard and must apply the statute as enacted by Congress without exception.

- (1) Plants of the 'Chanoud' variety entered the United States for the first time during December 1998 for confidential evaluation and testing under the growing conditions of the United States. Initially the plants were placed in quarantine and were released from quarantine during June 1999. Such plants were not available to the public.

- (2) It was indicated in Applicant's Declaration filed with the present Application that Plant Breeders Rights Application No. 15135 was filed in France on November 7, 1996. Attached as Exhibit A are pages from Protection Des Obtentions Végétales, Bulletin officiel du Comité de la Protection des Obtentions Végétales, No. 11 (1996). At Page 498 there is reference to the filing of French Plant Breeders Rights Application No. 15135, with only five words being used to describe the characteristics of the variety. At Page 504 reference to the proposed 'Chanoud' varietal denomination appears. Attached as Exhibit B is Page 26 from No. 1 (1999) of the same publication. At the last page there is reference to the grant of Breeders Rights No. 11092 on December 21, 1998.
- (3) Attached as Exhibit C are pages from the 1997 catalog of Challet Herault Productions of Nuaillé, France. The 'Chanoud' variety is shown at the second page of the exhibit.
- (4) Plants of the 'Chanoud' variety are understood to have first been placed in the hands of the public in France during 1997.
- (5) Plants of the 'Chanoud' variety were first placed on sale in the Untied States on October 15, 2000, and less than one year prior to the January 16, 2001 filing date of the present Plant Patent Application in the United States.

It respectfully is pointed out that information contained in the French publications of Exhibit A, Exhibit B, and Exhibit C with respect to the 'Chanoud' variety could not enable one skilled in plant science in combination with his or her own knowledge of the particular art to reproduce and to thereby be in possession of the claimed plant when taking into consideration the existing state of the art with respect to plant heredity, etc. Even the most skilled plant scientist could not go into the greenhouse or field and again create plants of the 'Chanoud' variety using all his or her skills. The underlying genetics are far too complex to achieve such result. In fact, even Applicant could not today reproduce the creation of the same 'Chanoud' variety with full knowledge of every word of the publication in view of the complex expression of genes that have been appropriately aligned in the claimed variety.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present Application. It was there held that in order to be a statutory bar, a printed publication with respect to a new plant variety that is sought to be patented under 35 U.S.C. §§ 161 to 165 must be adequate in its teachings to enable the reader in combination with his own scientific knowledge of the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." This holding says nothing about the knowledge of travel arrangements to potentially go seek a plant in a foreign country where it is not prior art

with respect to a U.S. Patent Application. The two rose varieties under discussion in the *LeGrice* case were available to the public outside the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210. This is further confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals Decision where it stated:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination in view of the express language utilized by Congress in 35 U.S.C. § 102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.*, Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. Had the availability of plants of the subject *LeGrice* varieties outside the United States been considered to be relevant in their evaluation, it would have been addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re LeGrice* decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to

plant variety protection and properly has been consistently applied and followed by Examiners of traditional Plant Patent Applications pursuant to 35 U.S.C. §§ 161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application has not been followed by Examiners of the U.S. Patent and Trademark Office in years past for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It is important to note that this has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. § 102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re LeGrice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is still today no way that even the most skilled plant scientist could reproduce the claimed 'Chanoud' variety from a reading of anything that was published with respect to this variety more than one year prior to the January 16, 2001 filing date of the present application. Also, it is improper to rely upon a combination of references in an effort to anticipate an invention under 35 U.S.C. § 102(b). See, *Studiengesellschaft Kohle*,

M.B.H. v. Dart Industries Inc., 726 F.2d 724, 726 (Fed. Cir. 1984). The mere possibility for one to seek a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Chanoud' variety.

The issuance of a formal Notice of Allowance is urged to be in order and respectfully is requested. Basic fairness to Applicant requires this outcome. If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved at a personal interview.

Respectfully submitted,

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MARKED-UP COPY OF SUBSTITUTE SPECIFICATION

BOTANICAL/COMMERCIAL CLASSIFICATION

Dendranthema grandiflora/Decorative Pot Mum

VARIETAL DENOMINATION

cv. 'Chanoud'

Summary of the Invention

The present invention comprises a new and distinct cultivar of Chrysanthemum, botanically known as *Dendranthema grandiflora*, and hereinafter is referred to by the cultivar name 'Chanoud'.

The new cultivar of the present invention was created at Nuaille, France during 1994 when plants of the 'Chadixi' cultivar (non-patented in the United States) were irradiated with gamma irradiation. Cuttings from the irradiated plant were used to produce new plants that were carefully studied. The new cultivar was selected during 1994 from among the rooted cuttings because of its distinctive combination of characteristics.

The 'Chadixi' parent was commercially available in France beginning in January 1992. The 'Chadixi' cultivar is not known to have ever been introduced for growing in the United States.

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It was found that the new Chrysanthemum cultivar of the present invention displays:

- (a) a low compact, well-branched, and generally uniform and spherical growth habit,
- (b) during October a profusion of attractive decorative light yellow double blossoms,
- (c) dark green leaves that contrast well with the light yellow blossoms, and
- (d) an ability to grow well in pots to provide an attractive potted gift plant.

The new cultivar is considered to be primarily an October-flowering greenhouse cultivar with natural flowering in weeks 42 to 43 at Nuaille, France. It can be grown well either singly or in clumps in pots. Also, the new cultivar is suited for growing in the landscape where it has withstood temperatures of 0° to -2°C. The blossoms commonly last in excess of three weeks on the plant. Pinching is helpful to further enhance branching; however, such pinching is not necessary since the plant already is naturally self-branching.

The new cultivar can be readily distinguished from its 'Chadixi' parent that exhibits purple blossoms. Unlike the 'Chadixi' parent the blossoms of the new cultivar of the present invention are light yellow in coloration. Such markedly

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different blossom coloration can be reliably used to distinguish the new cultivar from its parent.

Asexual reproduction of the new cultivar by cuttings initially taken during 1994 as performed at Nuaille, France, in a controlled environment has demonstrated that the characteristics of the new cultivar as herein described are firmly fixed and are retained through successive generations of asexual propagation.

The new cultivar also was tested during 1997 at Cambridge, Great Britain. 'Chanoud' has not been observed under all possible environmental conditions to date. Accordingly, it is possible that the phenotype may vary somewhat with variations in the environment, such as temperature, light, day length, contact with pesticides and/or subjection to growth regulation treatments.

Brief Description of the Photograph

The accompanying photograph was obtained during October, 1996 and depicts three plants of the new cultivar while growing in a pot in a greenhouse at Nuaille, France. The plants were rooted during June, 1996, and accordingly were approximately four months of age. The generally spherical growth habit and the profusion of attractive light yellow double decorative blossoms with dark green foliage are illustrated.

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Detailed Description

The chart used in the identification of colors described hereafter is the R.H.S. Colour Chart of the Royal Horticultural Society, London, England. In some instances more common color terms are provided and are to be accorded their usual dictionary significance. The plants described were grown in 20 cm. pots in greenhouses at Nuaille, France, three plants to a pot, and were rooted in mid-June, and were observed on October 20th. No growth regulation was used. The growing conditions approximated those commonly utilized for the commercial production of decorative pot mums.

[Classification:]

Botanical. - *Dendranthema grandiflora*,

cv. 'Chanoud'.

Commercial. - Decorative pot mum.]

Inflorescence:

A. Capitulum

Type. - Decorative.

Diameter across face. - Approximately 25 to 35 mm on average when fully expanded.

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- Bud shape. - Rounded and wider than long.
- Bud size. - Approximately 8 to 12 mm in length on average and approximately 12 to 16 mm in diameter on average.
- Outside bud coloration. - Yellow Group 10B.
- Number per plant. - Varies with cultural conditions. A 20 week old plant commonly bears approximately 600 to 900 flowers.
- Peduncle. - Commonly varies in length from approximately 2 to 5 cm on average and the diameter commonly is 1 to 3 mm on average. The color is near Yellow-Green Group 146C.

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Phyllaries. - Five in number, elongated and possess pointed tips, approximately 8 to 15 mm in length on average, approximately 2 to 3 mm in width on average, and near Green Group 139A in coloration.

B. [Corolla] Ray florets

General tonality. - [Outer Side] Upper Surface: Yellow Group 5D with some very light red that increases slightly towards the base. Such red coloration is difficult to describe more fully and commonly requires the destruction of the flower for it to become apparent.

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- [Inner Side] Under
Surface: Yellow Group
5D.
- Number of ray florets. Varies with flower position
on the inflorescence and
cultural conditions.
Commonly approximately
120 to 180 on average.
- Size of ray florets. Varies with position and
commonly range from
approximately 0.8 to
3.5 cm in length on
average and from
approximately 0.2 to
0.6 cm in width on
average.

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In contrast the floret
coloration of the parent
'Chadixi' variety is Purple
Group 75C with some
slightly deeper shading and
edges of Purple Group
75B.

- Configuration ray florets. - [Petaloid] Acropetal with a
dentate apex, a
substantially straight base
and a smooth margin.
- Disc florets. - None.

C. Reproductive organs

- Androecium. - Present with ray florets at
the center of the capitulum.
- Gynoecium. - Present with ray florets at
the center of the capitulum
at the end of blooming.

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- Pollen. - Generally formed in only a slight quantity at the end of blooming and yellow-orange in coloration.
- Fragrance. - Weak and typical of Chrysanthemum.

Plant:

A. General Appearance

- Height. - Very short, and approximately 35 cm on average at four months of age.
- Width: - Approximately 55 cm on average at four months of age.

B. Foliage

- Color. - Upper Surface: Generally between Green Group

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137A and Green Group

139A.

- Under Surface: Generally between Green Group

137A and Green Group

139A with slightly more grey.

Shape. - Possess dentate lobes.

Size. - The leaves at the tip of the stem commonly are approximately 3.5 cm in length and commonly are approximately 1.7 cm in width. The leaves at the base of the stem commonly are approximately 10 cm in length and commonly are approximately 5 cm in width.

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|---|--|
| <u>Bearing.</u> | - <u>Petiolate.</u> |
| <u>Texture.</u> | - Fleshy. |
| <u>Thickness.</u> | - [Medium] <u>Moderately</u>
<u>thick.</u> |
| <u>Serration.</u> | - Fine. |
| <u>Shape of base of leaf.</u> | - Obtuse. |
| <u>Shape of tip of leaf.</u> | - Mucronate. |
| <u>Claw in base of sinus
between lateral lobes.</u> | - Absent. |
| <u>Petiole.</u> | - <u>Approximately 0.5 to 2 cm</u>
<u>in length, and</u>
<u>approximately 2 to 4 mm</u>
<u>in thickness.</u> |
| <u>Stems.</u> | - Thin to medium and
generally round in cross-
section, strongly rigid, and
commonly Yellow-Green
Group 146C in coloration
with no anthocyanin
coloration. |

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Internode length. - Very short, and commonly approximately 5 to 10 mm.

C. Resistance to Diseases

Requires no particular treatment when compared to other Chrysanthemum varieties.

D. Resistance to Insects

Requires no particular treatment when compared to other Chrysanthemum varieties.

E. Response Period

The 'Chanoud' cultivar is natural blooming and the reaction period is not considered to be a significant characteristic.
However, such reaction period has been observed to commonly vary between 7.5 and 8.5 weeks.